

REMARKS

The present Amendment is being filed in response to the Official Action dated June 22, 2007 placing the present patent application under final rejection. A Request For Continued Examination (RCE), together with the applicable filing fee, is being filed concurrently herewith.

On August 29, 2007, the undersigned conducted a telephone interview with Examiner MacArthur, and inquired if the Examiner would consider revised Claim 1, as presented herein, in response to the Final Action. The Examiner stated that he would not consider the revised claim on the grounds that it would raise new issues requiring further search or consideration by the Patent & Trademark Office. Accordingly, Applicant has filed a Request For Continued Examination (RCE) to permit the Examiner to consider the revised claim on the merits, notwithstanding the final action.

Starting at the last paragraph of page 3 of the Official Action dated June 22, 2007, the Examiner states that the Amendment filed by Applicant on April 23, 2007 presents arguments in support of the allowance of Claim 1, which are based upon functional features which are not expressly recited in the claim. In response to the Examiner's comments, independent Claim 1 has

now been revised to expressly recite the functional features of the claimed invention as argued in the Amendment filed on April 23, 2007. The amendments to the claim herein are supported by original specification at page 1, 3rd and 4th paragraph, and page 2, second paragraph.

Applicant notes that it is well established that functional recitations in an apparatus claim are entitled to consideration in the patentability determination of the claim. See, for example, In re Hallman, 210 USPQ 609 (CCPA 1981), in which the Court held that it is proper to define a product by what it does rather than by what it is, and to the extent that functional recitations distinguish the product over the prior art, the functional recitations are entitled to the same consideration as traditional structural limitations. Applicant therefore respectfully submits that the functional recitations now included in independent Claim 1 are entitled to full consideration in the patentability determination.

In the Official Action dated June 22, 2007, independent Claim 1, the only claim pending in the present application, was rejected under 35 U.S.C. Section 102(b) as being anticipated by Ponto (U.S. Patent No. 1,701,985). As discussed starting at page 8, last paragraph, through page 9, first paragraph of the prior Amendment, a rejection of a claim as being anticipated by a prior

art reference requires the Patent & Trademark Office to establish a strict identity of invention between the applied reference and the rejected claim. In the present case, it is clear that Ponto does not teach independent Claim 1, including the specific functional features of the claimed invention as now expressly recited in the claim. Therefore, Ponto does not anticipate independent Claim 1, as revised herein.

Moreover, although Claim 1 was not rejected under 35 U.S.C. Section 103(a) in the outstanding Official Action, Applicant submits that independent Claim 1, as revised herein, cannot be considered obvious over the disclosure of the Ponto patent. The Ponto patent clearly does not suggest or recognize the functional advantages of the apparatus defined by Claim 1, as amended herein, as now expressly recited in the claim.

Independent Claim 1 now expressly recites that percussion energy is transmitted from the rock drilling machine to the rock bolt during a percussion operation when the locking device is unloaded. This functional feature of the claimed apparatus overcomes disadvantages of known devices, as discussed at page 1, third paragraph of Applicant's specification. Also see page 2, second paragraph of Applicant's specification.

Independent Claim 1 also expressly recites that the locking device retains the rock drilling machine connected to the coupling sleeve when the rock bolt is disconnected from the coupling sleeve. This functional feature recited in independent Claim 1 is discussed at page 1, fourth paragraph and page 2, second paragraph of Applicant's specification.

The Ponto patent does not teach, suggest or recognize either of these two functional features of the apparatus defined by independent Claim 1, as amended herein. As note above, the functional recitations recited in independent Claim 1 are entitled to full patentable consideration in the patentability determination. Therefore, when independent Claim 1 is considered as a whole in its entirety, it is clear that the Ponto patent does not suggest or recognize the claimed apparatus, since there is not motivation or suggestion in the prior art itself to modify the Ponto disclosure in any manner rendering independent Claim 1 obvious. Since the prior art itself does not provide any such suggestion or motivation, the only basis for modifying the Ponto disclosure to render independent Claim 1 obvious can be derived only by the use of Applicant's own disclosure as a guide for the modification, which would constitute an improper hindsight reconstruction of the claim.

Applicant respectfully submits that independent Claim 1, as amended herein, is patentable over the prior art reference applied to reject the claim, and respectfully requests favorable action.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'Mark P. Stone', with a stylized flourish at the end.

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